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JR**PRE-APPEAL BRIEF REQUEST FOR REVIEW**Docket Number (Optional)
05793.3130-00000

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on _____

Signature _____

Typed or printed name _____

Application Number
10/820,797Filed
April 9, 2004First Named Inventor
Roy E. LowranceArt Unit
2161Examiner
Paul Kim

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached sheets.

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

Signature

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

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October 4, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of 1 form is submitted.

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PATENT
Customer No. 22,852
Attorney Docket No. 05793.3130-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Roy E. LOWRANCE et al.) Group Art Unit: 2161
)
Application No.: 10/820,797) Examiner: KIM, Paul
)
Filed: April 9, 2004) Confirmation No.: 8723
)
For: METHODS AND SYSTEMS FOR)
VERIFYING THE ACCURACY OF)
REPORTED INFORMATION)

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the Final Office Action mailed May 4, 2007. This Request is being filed concurrently with a Notice of Appeal.

I. Requirements For Submitting a Pre-Appeal Brief Request for Review

Applicants have met each of the requirements for a pre-appeal brief review of rejections set forth in an Office Action. This application has been at least twice rejected, and Applicants have filed a Notice of Appeal, but not yet an Appeal Brief, with this Request. Lastly, Applicants submit a Pre-Appeal Brief Request for Review that is five (5) or less pages in length and sets forth legal or factual deficiencies in the rejections. (See Official Gazette Notice, July 12, 2005.)

Applicants therefore request review of the Examiner's rejections in the Final Office Action of May 4, 2007, for the following reasons.

II. Outstanding Rejections

In the Final Office Action mailed May 4, 2007, the Examiner rejected claims 1-11, 22-32, and 43-51 under 35 U.S.C. § 102(e) as being anticipated by *Hillis et al.* (U.S. Patent Publication No. 2003/0196094)¹ and rejected claims 6, 27, and 48 under 35 U.S.C. § 103(a) as being unpatentable over *Hillis et al.* in view of the Examiner's Official Notice.

III. The Rejection of Claims 1, 3, 5-11, 22, 24, 26-32, 43, 45, and 47-53 is Legally Deficient Because the Examiner Does Not Demonstrate Where the Prior Art Discloses Each and Every Recitation of the Claims

In order to properly establish that *Hillis et al.* anticipates Applicants' claimed invention under § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

The § 102(e) rejection of claims 1, 3, 5-11, 22, 24, 26-32, 43, 45, and 47-53 is legally deficient because *Hillis et al.* fails to disclose each and every element of each of the claims.

1. Generating a Hash Based on Ingredient Data as Recited in Claim 1

Claim 1 recites, among other things:

generating a hash based on ingredient data related to the generation of the report, wherein the ingredient data comprises the report information, the one or more query statements, and at least one of a date and time the report was generated and a version of the report information.

Hillis et al. fails to disclose the above generating step. Instead, *Hillis et al.* discloses that the "type" and "content" of a data object are used to generate a hash value. (*Hillis et al.* ¶ 0242.) *Hillis et al.* defines data "type" to include "text, image, sound, video and structured data." (*Id.* at ¶¶ 0173-0176 and FIG. 2) Accordingly, the data "type" disclosed by *Hillis et al.* does not equate to "one or more query statements, and at least one of a date and time the report was generated and a version of the report information," as recited in independent claim 1.

1. Although the heading of the rejection only indicates claims 1-9, 22-30, and 43-51 as rejected, the body of the rejection rejects claims 1-11, 22-32, and 43-53. Applicants assume that it was the Examiner's intention to reject claims 1-11, 22-32, and 43-53 under 102(e) in view of *Hillis et al.* Furthermore, claims 2, 4, 12-21, 23, 25, 33-42, 44, and 46 were cancelled by the Amendment filed on February 12, 2007.

In the Advisory Action mailed August 13, 2007, the Examiner appears to equate “content,” as disclosed by *Hillis et al.*, with the claimed “one or more query statements, and at least one of a date and time the report was generated and a version of the report information.” (*Advisory Action*, p. 2.) However, the Examiner points to no support in the teachings of *Hillis et al.* for this conclusion, nor can Applicants find such a teaching or suggestion in *Hillis et al.*

Moreover, as indicated in the Reply to Office Action filed on August 3, 2007, p. 3, the generated hash value of *Hillis et al.* is “used to identify and register the data object into [a] registry and is used as the index in the registry’s hash table.” (*Hillis et al.* at ¶ 0242.) This hash value is referred to as the “index hash.” (*Id.*) “Along with the index hash and signature, a hash table entry contains a data identifier 110 describing the data object’s type length, and one or more representations of the object’s data 111, 112. The hash table entry also contains a metadata identifier 113, which includes an indication of the annotations of the data object.” (*Id.* at ¶ 0245.) The Examiner asserts that “wherein the annotations may be added automatically to the document data, said annotations identifying the creation date may indeed be a part of the content used in generating a unique hash.” (*Advisory Action*, p. 2.) However, again the Examiner improperly fails to point to any support within *Hillis et al.* for this assertion and Applicants cannot find such a teaching or suggestion in *Hillis et al.* In fact, as illustrated in FIG. 17a of *Hillis et al.*, an index hash is generated only from the “type” and “content” of the data object. As further illustrated in FIG. 17a, the hash table 69 is a representation of the data object 100 and hash table entry 107 includes index hash and “any associated information annotating the data.” (*Hillis et al.*, ¶ 0244.) Nowhere in *Hillis et al.* is there a teaching or suggestion that these annotations are “a part of the content used in generating a unique hash,” as alleged by the Examiner.

2. Outputting the Report as Recited in Claim 1

Claim 1 recites, among other things:

outputting the report, the report including the report information and a copy of the generated hash stored in the database, wherein the stored hash and the ingredient data may be subsequently accessed using the copy of the hash included in the report to verify the report information.

In the Advisory Action, the Examiner alleges that “it would have been both inherent and necessary to the disclosed invention to include said hash or signature within the documents such that the document may be authenticated accordingly.” (*Advisory Action*, p. 2.) However, the Examiner’s position is unreasonable in light of the disclosure of *Hillis et al.* Indeed, the authentication process of *Hillis et al.* operates entirely contrary to the Examiner’s allegation. Specifically, *Hillis et al.* discloses that the hash is not included in an output of the report, but instead must be computed by a user, using for example, a publicly available algorithm. (See, e.g., *Hillis et al.* at ¶¶ 0381, 0385, and 0400.) Accordingly, the Examiner has failed to meet the burden of proving inherency as it is not “clear that the missing descriptive matter is necessarily present in the thing described in the reference.” See M.P.E.P. § 2112, quoting *In re Oelrich*, 666 F.2d 578, 581-82, 212 U.S.P.Q.2d 323, 326 (CCPA 1981).

As a result, the rejection of independent claim 1 under § 102(e) is legally deficient because each and every recitation of the claim is not disclosed or inherent in the teachings of *Hillis et al.*, and the Examiner does not demonstrate to the contrary.

Independent claims 22 and 43, although of different scope than claim 1, recite similar subject matter and, as a result, the rejection of these claims under § 102(e) is also legally deficient. Dependent claims 3, 5-11, 24, 26-32, 45, and 47-53 are also not anticipated by *Hillis et al.* at least by virtue of their respective dependence from claims 1, 22, and 43. Therefore, the rejection of claims 1, 3, 5-11, 22, 24, 26-32, 43, 45, and 47-53 under § 102(e) should be withdrawn.

IV. The Rejection of Claims 6, 27, and 48 under 35 U.S.C. § 103(a) is Legally Deficient Because the Examiner Improperly Takes Official Notice and Ignores Applicants’ Arguments Related to the Official Notice

In the Final Office Action, the Examiner rejected claims 6, 27, and 48 under 35 U.S.C. § 103(a) as being unpatentable over *Hillis et al.* in view of the Examiner’s Official Notice. The Examiner’s rejection of claims 6, 27, and 48 is legally deficient because a *prima facie* case of obviousness has not been met.

As discussed above, *Hillis et al.* fails to teach all the recitations of independent claims 1, 22, and 43 from which claims 6, 27, and 48 respectively depend. Moreover, the Examiner’s Official Notice does not cure these deficiencies of *Hillis et al.* nor does the Examiner rely on the Official Notice for such teachings. Instead, the Examiner relies on the Official Notice to allege that it would have been obvious to one of ordinary skill in the

art to utilize the claimed format of the query statements. (*Final Office Action*, p. 5.) This does not properly address the missing recitations of *Hillis et al.*, and as a result, the rejection of claims 6, 27, and 48 is legally deficient.

Further, in the Advisory Action mailed August 13, 2007, the Examiner alleges that because "Applicant has inadequately traversed the Official Notice and is therefore deficient, no document evidence shall be provided by the Examiner." (*Advisory Action*, p. 2.) Not only is the Examiner's position improper, it is factually inaccurate. In the August 3, 2007 response, Applicants dedicated over a page and a half of remarks to the deficiencies of the Examiner's Official Notice. (*Reply to Office Action*, filed August 3, 2007, p. 6.) Specifically, Applicants submitted "that the query statement format in the context of claims 6, 27, and 48 is not well known" and requested the Examiner to cite a competent prior art reference in substantiation of the Examiner's conclusions. (*Id.*)

Accordingly, because the Examiner's Official Notice is improper and does not address the deficiencies of *Hillis et al.*, and because the Examiner does not address Applicants' arguments to this issue, the rejection of claims 6, 27, and 48 under 35 U.S.C. § 103(a) is legally deficient, and should be withdrawn. (M.P.E.P. § 2144.03.)

V. Conclusion


In light of the above arguments, Applicants submit that the outstanding rejections are legally deficient. Therefore, Applicants respectfully request that the rejection of claims 1, 3, 5-11, 22, 24, 26-32, 43, 45, and 47-53 be reconsidered and withdrawn, and the claims allowed.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 4, 2007

By: _____


Arthur A. Smith
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